REMARKS

In the non-final Office Action mailed on September 21, 2005, the Examiner:

rejected claims 22-24 and 34 under 35 U.S.C. § 101 as non-functional descriptive material;

rejected claims 2, 7-14, 16, 19-21, 28, 29 and 35-37 under 35 U.S.C. § 101;

rejected claims 42, 43 and 48-51 under 35 U.S.C. § 112, first paragraph;

rejected claims 2-6, 13, 14, 16-22, 28-31, 33-36, 38-41 and 44-47 under 35 U.S.C. § 102(a) over U.S. Patent No. 5,960,409 to Wexler ("Wexler");

rejected claims 1 and 25-27 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,487,538 to Gupta et al. ("Gupta") in view of Wexler;

rejected claims 7-12, 15, 23, 24, 32 and 37 under 35 U.S.C. § 103(a) over Wexler in view of Gupta; and

rejected claims 42, 43 and 48-51 under 35 U.S.C. § 103(a) over Wexler in view of U.S. Patent No. 6,708,335 to Ozer et al. ("Ozer").

Applicants herein cancel claims 42, 43, and 48-51. As a result, claims 1-41 and 44-47 are pending. Further examination and review in view of the amendments and remarks below are respectfully requested.

Applicants' Techniques

Applicants' techniques are directed to selecting a publisher's web site that is likely to produce good results for a particular advertiser if the advertiser places advertising there. In some cases, Applicants' technique evaluates candidate publishers based on the assessments of their inclination and/or affinity. Both inclination and affinity have to do with the extent to which a particular pair of web sites is visited by the same users. Inclination measures the extent to which users that visit the advertiser's web site also visit a candidate publisher's web site. Affinity measures the extent to which users that visit a publisher web

site on which the advertiser conducted a successful advertising campaign in the past also visit a candidate publisher web site.

Wexler

Wexler describes an approach for providing on-line third party accounting and statistical information. (col. 2, lines 38-39.) In Wexler, banners that are published for the benefit of an advertiser and presented by a user's web browser point to or address a third-party accounting and statistical service. When the user clicks on a banner, the third-party accounting and statistical service receives the download request signal from the user's web browser. The third-party accounting and statistical service accumulates and tabulates statistical information including the number of clicks on the advertiser's banner, and data indicative of the effectiveness of the advertising medium. (col. 2, lines 40-61.)

Gupta

Gupta describes a technique for local advertising on the Internet. According to the described technique, Internet Service Providers (ISPs) or proxies owned by an ISP insert advertisements that are transmitted from a web host to a client. Alternatively, any entity may insert or replace an advertisement that is transmitted to a client.

I.   Rejections under 35 U.S.C. § 101

The Examiner rejected claims 22-24 and 34 under 35 U.S.C. § 101 as non-functional descriptive material, in that the described data structure is "simply a data file – no functional change occurs when an application program uses the structural data." Applicants respectfully traverse this rejection. Applicants respectfully submit that claims 22-24 and 34 are directed to a data structure stored on one or more computer memories that enables the selection of a candidate advertising outlet and, thus, imparts functionality. The courts have found such data structures that impart functionality when encoded on a computer-readable medium to be statutory subject matter. *See e.g., In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on

a computer readable medium that increases computer efficiency held statutory); *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (claim to computer having a specific data structure stored in memory held statutory product-by-process claim). A claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. MPEP § 2106(IV)(B)(1)(a).

The Examiner rejected claims 2, 7-14, 16, 19-21, 28, 29 and 35-37 under 35 U.S.C. § 101. In particular, the Examiner stated that "[f]or a claimed invention to be statutory, the claimed invention must be within the technical arts," and that "[f]or a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts." Applicants respectfully traverse this rejection. Applicants respectfully submit that claims 2, 7-14, 16, 19-21, 28, 29 and 35-37 are directed to statutory subject matter in that the Board of Patent Appeals and Interferences recently held that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. *Ex parte Lundgren*, Appeal No. 2003-2088 (Bd. Pat. App. & Interf., Apr. 20, 2004). In light of the *Ex parte Lundgren* decision, Applicants respectfully submit that this rejection be withdrawn.

II.   Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 42, 43 and 48-51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Without conceding the propriety of the rejection of these claims, Applicants herein cancel claims 42, 43 and 48-51 to obviate this rejection.

III.   Rejections under 35 U.S.C. § 102(a) and § 103(a)

Claims 1-41 and 44-47 stand rejected over Wexler, either alone or in combination with Gupta. Applicants respectfully traverse the Examiner's rejections.

The Examiner rejected claims 42, 43 and 48-51 under 35 U.S.C. § 103(a) over Wexler in view of Ozer. As indicated above, Applicants herein cancel claims 42, 43 and 48-51 making this rejection moot.

Claims 1-24, 36-41 and 44-47 each recite an <u>inclination</u> metric for determining the desirability of placing with an electronic publisher an advertising message for an advertiser. The inclination metric is a measure of the extent to which users that visit the advertiser (e.g., the advertiser's web site) also visit an electronic publisher (e.g., a candidate electronic publisher's web site), irrespective of whether either one of these two web sites is visited as the result of following a link to it on a page of the other web site. In response to Applicants' argument in their June 29, 2005 Appeal Brief that "click-through" data is an indication of a "referral" from one web site (e.g., banner publisher's web site) to another (e.g., banner advertiser's web site) in that a user at a first web site clicks-through to a second web site (p. 16), the Examiner stated:

> The Examiner answers that the Applicant is arguing about features that are not stated in the claims. Nowhere, [sic] in the claims is stated that said inclination data cannot be obtained from click-through data.

(present Office Action, p. 21.)

Applicants respectfully disagree. Independent claim 1 includes inclination data by explicitly reciting (1) selecting the user identifiers contained in stored indications of the first type, (2) determining the number of unique selected user identifiers, and (3) for each of the electronic publishers, determining the number of selected user identifiers that are contained in at least one indication of the second type that also contains an identifier of the electronic publisher to obtain a count for the electronic publisher, and dividing the count for the electronic publisher by the number of unique selected user identifiers to <u>obtain an inclination metric</u> for the electronic publisher. Independent claim 2 includes inclination data by explicitly reciting (1) identifying a plurality of users that have visited the candidate advertising outlet, (2) counting the number of identified users that have also visited the

selected advertiser, and (3) generating for the candidate advertising outlet <u>a metric that</u> <u>compares the number of identified users to the number of counted users</u>. Independent claims 22 includes inclination data by explicitly reciting, for a selected advertiser having a web page and each of a plurality of candidate advertising outlets, the fraction of visitors to the web page of the selected advertiser that also visited the candidate advertising outlet. Independent claim 23 includes a variation of inclination data by explicitly reciting, for a selected advertiser having a web page and each of a plurality of candidate advertising outlets, the fraction of visitors to the web page of the selected advertiser that both (a) visited the candidate advertising outlet and (b) did not view an advertising message of the advertiser. Similarly, independent claim 24 includes another variation of inclination data by explicitly reciting, for a selected advertiser having a web page and each of a plurality of candidate advertising outlets, the fraction of visitors to the web page of the selected advertiser that also visited the candidate advertising outlet and before first viewing an advertising message of the advertiser. Independent claim 35 includes inclination data by explicitly reciting, for each of a first plurality of advertising outlets, assessing the rate at which visitors to the advertiser also visit the advertising outlet. Likewise, independent claim 36 includes inclination data by explicitly reciting (1) for each of a plurality of advertising outlets, determining a first number of consumers observed to visit the advertising outlet, (2) for each of the advertising outlets, of the number of different consumers observed to visit the advertising outlet, determining a second number of consumers that also visited the advertiser, and (3) for each advertising outlet, dividing the second value by the first value to obtain an inclination value.

First, as indicated above, each of claims 1-24, 36-41 and 44-47 recites inclination data. Second, the recited inclination data language is distinct from click-through data. As discussed above, click-through data is an indication of a referral from one web site (e.g., banner publisher's web site) to another (e.g., banner advertiser's web site) in that a user at a first web site clicks-through to a second web site. The recited inclination data is not obtained by counting click-through data but, rather, by determining the extent to which

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users that visit the advertiser's web site also visit a candidate publisher's web site irrespective of whether one of these two web sites is visited as the result of following a link to it on a page of the other web site.

In rejecting the claims in the present Office Action, the Examiner indicated that Wexler's statistical report (col. 2, lines 20-62; col. 5, lines 24-30; col. 6, lines 1-10) corresponds to Applicants' inclination metric.

Applicants respectfully disagree. Wexler does not disclose, suggest or teach inclination metric for determining the desirability of placing with an electronic publisher an advertising message for an advertiser. Wexler merely describes an accounting and statistical service that maintains a count of click-through data and other statistics that are based on the click-through data, as indicated at col. 5, line 66-col. 6, line 10, which recites in its entirety:

> As appropriate, the third party accounting and statistical service 13 can provide a report to the advertiser and/or the banner publisher. The report may include statistic such as, for example, the number of clicks on the banner 5, the percentage of clicks that result from the banner 5 being displayed on a particular banner publisher's Web page if the total number of impressions is known, the number of clicks on the banner per day, the date and time of each click, the origin of the user and so forth. Additionally, the report may include correlations developed from such statistics and illustrative charts and graphs. Typically, such a report would be provided on a regular basis.

The statistics that are included in the report are all based on the number of clicks on a banner. Col. 2, lines 20-62 of Wexler also recites tabulating the number of clicks on the advertiser's banner as further data indicative of the effectiveness of the banner publisher's web page as an advertising medium. Likewise, col. 5, lines 24-30 recites a statistic for showing the effectiveness of a banner-publishing site. Wexler's click-through statistic is not an inclination metric. Applicants can find in Wexler and Gupta no such disclosure or suggestion.

Claims 25-35 each recite an __affinity__ metric, alone or in combination with an inclination metric, for determining the desirability of placing with an electronic publisher an advertising message for an advertiser. The affinity metric is a measure of the extent to which users that visit a publisher web site on which the advertiser conducted a successful advertising campaign in the past also visit a candidate publisher web site.

The Examiner rejected claims 25-27 on the same basis as claim 1. Claims 25-27 recite features that are different than the features recited in claim 1, and which the Examiner failed to indicate where and how Wexler and Gupta suggest or teach these features. For example, claims 25-25 each recite "dividing the product of the first and third quantities by the product of the second and fourth quantities to obtain an affinity metric for the candidate publisher" and "analyzing the affinity metrics obtained for the candidate electronic publishers." By applying the rejection of claim 1 to claims 25-35, the Examiner has failed to show how Wexler and Gupta disclose, suggest or teach all the elements recited in claims 25-27. Applicants find in Wexler and Gupta no such disclosure or suggestion.

In rejecting claims 28-34, the Examiner has failed to show how Wexler discloses, suggests, or teaches the affinity metric. Claims 28-33 each recite "for each of the candidate advertising outlets, measuring the tendency of visitors to the distinguished advertising outlet to visit the candidate advertising outlet to obtain an affinity metric for the candidate advertising outlets." Similarly, claim 34 recites "for each of a plurality of candidate advertising outlets, the extent to which visitors to the selected advertising outlet also visited the candidate advertising outlet." The Examiner has failed to indicate where and how Wexler suggests or teaches the affinity metric, as recited. As discussed above, Wexler's click-through data is an indication of a referral from a banner publisher's web site to a banner advertiser's web site in that a user at the banner publisher's web site clicks-through to the banner advertiser's web site. This is different from the affinity metric. Applicants can find in Wexler no such disclosure or suggestion.

Claim 35 recites an affinity metric by, for each of a second plurality of advertising outlets, assessing the tendency of a high-performing advertising outlet to drive its visitors to the advertising outlet among the second plurality of advertising outlets. In rejecting this claim, the Examiner indicated that Wexler's click-through statistic (col. 6, lines 1-10), corresponds to the recited affinity metric. As discussed above, Wexler's click-through data is distinct from an affinity metric. Applicants can find in Wexler no such disclosure or suggestion.

IV. **Conclusion**

In view of the foregoing, Applicants respectfully submit that claims 1-41 and 44-47 are allowable and ask that this application be passed to allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8000.

Dated: December 21, 2005   Respectfully submitted,

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